

**REMARKS****Status of the Claims**

Claims 1, 5-6, 8, 12-14, and 18-19 are currently present in the Application, and claims 1, 8, and 14 are independent claims. Claims 1, 8, and 14 have been amended, claims 7 and 20 have been cancelled and no claims have been added in this Amendment. Applicants are not conceding in this Application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the Examiner. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

In particular, Applicants have amended independent claim 1 to include limitations previously found in dependent claim 7 and have amended independent claim 14 to include limitations previously found in dependent claim 20 and have therefore canceled claims 7 and 20.

**Claim Rejections – Alleged Obviousness Under 35 U.S.C. § 103**

Claims 1, 5, 6, 8, 12-14, 18, and 19 were rejected under 35 U.S.C. § 103 as allegedly being obvious, and therefore unpatentable, over U.S. Patent Publ. 2003/0229529 by Mui et al. (hereinafter “Mui”) in view of U.S. Patent Publ. 2003/0110067 by Miller et al. (hereinafter “Miller”) in further view of U.S. Patent Publ. 2002/0198765 by Magrino et al. (hereinafter “Magrino”). Applicants respectfully traverse the rejections.

As amended, Applicants independent claims claim a method, an information handling system, and a computer program product that each include common elements of:

- retrieving one or more core skills from a data store, wherein each user is associated with one or more of the core skills, and wherein each of the core skills is a generalized skill useful in supporting an organization’s business objectives;

- retrieving, from a data store, a subset of dimension skills from a plurality of dimension skills, wherein the subset of dimension skills correspond to a subset of the plurality of users, and wherein each of the dimension skills is a profession-related skill corresponding to a particular profession found in the organization;
- identifying a progression requirement stored in a memory for each of the core skills and for the subset of dimension skills;
- including the retrieved core skills, the subset of dimension skills, and the identified progression requirements in a profession-specific framework module, wherein the including further comprises:
  - creating the profession-specific framework module corresponding to one or more of the users;
  - assigning one or more values to the retrieved core skills and to the subset of dimension skills;
  - storing the assigned values in the framework module;
- storing the profession-specific framework module in a data store accessible by an evaluation software routine;
- evaluating one of the plurality of users using the framework and the evaluation software routine, the evaluating resulting in an evaluated user wherein the evaluation software routine performs steps comprising:
  - retrieving a user capability from a capabilities data store, the user capability corresponding to the evaluated user;
  - matching the user capability with one of the progression requirements that are included in the framework;

- computing a core skill ranking for each of the core skills by comparing the values assigned to the core skills to the values assigned to other employees stored in the profession-specific framework module and computing a dimension skill ranking for each of the subset of dimension skills by comparing the values assigned to the subset of dimension skills to the values assigned to other employees stored in the profession-specific framework module, wherein the core skill rankings and the dimension skill rankings are stored in a memory;
- computing an overall ranking based upon the computed core skill ranking and the computed dimension skill ranking, wherein the overall ranking is stored in the memory; and
- identifying a plurality of user improvement areas based on the core skill rankings and the dimension skill rankings, wherein at least one of the user improvement areas corresponds to one of the core skills, wherein at least one of the user improvement areas corresponds to one of the dimension skills, and wherein the identified user improvement areas are selected in order to increase the overall ranking of the user.

The Final Office Action argues that Applicants' claimed limitations of different categories of skills, termed "core skills" and "dimension skills" are "merely non-functional descriptive material and are thus not given patentable weight." Applicants respectfully disagree.

The Examiner essentially admits that the prior art does not expressly distinguish between different types of skill categories. Indeed, the prior art simply shows evaluation of one category of skills (e.g., technical skills claimed by Applicants as "dimension skills"). Without being able to cite a reference that distinguishes various categories of skills, as taught and claimed by Applicants, the Examiner instead asserts that these important claim elements are not relevant as they are merely "non-functional descriptive

material.” Applicants strongly disagree and respectfully submit that the Examiner is not using the correct definition of non-functional descriptive material.

The section of the Manual of Patent Examining Procedure that discusses non-functional descriptive material reads as follows (MPEP § 2106(IV)(B)(1)(b), emphasis added):

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under **35 U.S.C. 101**. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

**Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101.** The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter.

For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Appellant's "claimed invention as a whole" is clearly statutory under 35 U.S.C. § 101. Rejections based on non-statutory descriptive material are typically used to prevent claims for music, literary works, etc. Material that is not patentable, such as a song, can not become patentable merely because it is stored, for example, on a compact disk. However, once a claim is deemed to be statutory, the Examiner can not ignore elements of the claim by asserting that they are "non-functional descriptive material." This is shown by the example given in the MPEP section cited above. Although a sequence of notes is not patentable on its own, a computer program that recognizes a sequence of notes and then causes another sequence of notes to be played, is patentable. Assuming, as an example and solely for the sake of argument, that the "core skills" or the "dimension skills" claimed by Applicants would not be patentable on their own, once they become integral parts of a statutory claim, they can not be ignored.

According to the Manual of Patent Examining Procedure § 2143.03 (emphasis added), "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art," (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Applicants assert that all the claim limitations, including the limitations pertaining to a "core skill," and a "dimension skill" must be considered when determining whether the claims are non-obvious in view of the prior art.

Furthermore, Applicants firmly believe that the core skills and the dimension skills claimed by Applicants are **not** non-functional descriptive material, but rather are a necessary part of the functional and structural relationship claimed in claims 1, 8, and 14. As claimed, the core skills reflect an employees non-technical skills, such as leadership abilities, teamwork and business acumen, while the dimension skills reflect

the employees technical expertise, such as the employee's expertise in areas such as enterprise systems, applications, information management, integration, and infrastructure (see, e.g., Applicants' Figure 4 and corresponding text that discusses the key differences between these categories of skills).

Neither Mui nor Miller nor Magrino, alone or in combination with one another, teach nor suggest the limitations set forth in Applicants independent claims, as amended. Applicants have further amended the claims to clarify that the dimension skills and dimension skills pertaining to employees are stored in a "profession-specific framework module." Support for this amendment is found in Applicants specification (see, e.g., Figure 5, element 580 that creates module corresponding to a particular profession, etc.). Applicants careful reading of the prior art references reveals that none of the cited prior art references teach or suggest creation of **profession-specific framework modules** used to store both core and dimension skill data pertaining to an employee. Instead, the references teach evaluating employees based on one category, or type, of skill and do not teach creation of framework modules and definitely do not teach or suggest creating and using "profession-specific" framework modules, as taught and claimed by Applicants.

In addition, Applicants maintain that Applicants claim retrieving and evaluating a user, such as an employee, based upon both "core skills" as well as "dimension skills." Both these types of skills are defined in Applicants' specification and, as suggested by the Examiners for clarification, clarifying language has been added to the independent claim with "core skills" being claimed to be "a generalized skill useful in supporting an organization's business objectives," while "dimension skills" are claimed to be "a profession-related skill corresponding to a particular profession found in the organization." Examples of "core skills" may include "leadership," "communication," and "teamwork" skills because no matter what an individuals particular profession (e.g., engineer, software developer, marketing, etc.) these skills are each generalized skills helpful in supporting business objectives. In contrast, "dimension skills" pertain to a particular profession. Using the example from above, an engineer's dimension skills

may include circuitry design, power design, and the like, while the programmer's dimension skills may include understanding various programming languages and platforms. Likewise, the marketing professional's dimension skills may include knowledge of lease agreements, knowledge of particular contracts, and the like. What has been found is that systems, such as those described by Mui and Miller, are one-dimensional and only account for one type of skill. These systems either have general evaluation criteria where each employee is measured by the same set of skills (e.g., core skills) without regard to their particular profession, or narrow evaluation criteria is used to evaluate an employee's competency in a particular profession. While both types of systems are useful, the systems described by Mui and Miller do not address both types of skills.

The Office Action contends that Mui teaches *"retrieving one or more core skills, wherein each core skill corresponds to each of a plurality of users;"* However, a review of Mui reveals that Mui discusses an Information Distributor that appears directed at web resources and while it simply mentions "skills and competencies." Nowhere does Mui teach or suggest retrieving skills that correspond to a plurality of users as claimed by Applicants.

The Office Action contends that Mui teaches *"retrieving a subset of dimension skills from a plurality of dimension skills, wherein the subset of dimension skills correspond to a subset of the plurality of users."* As described above, Applicants include both "core skills" and "dimension skills" with core skills being defined as "generalized skills that are required from each employee in order to support an organization's business objectives" and dimension skills being defined as those that "relate to a particular profession" (see p. 4-5 of Applicants' specification for support of the similar claim amendments added to these limitations for clarification purposes). In the first limitation above, Mui does not teach storing or retrieving "core skills" and instead is focused on rather detailed programming skills (e.g., "dimension skills"). The Office Action contends that Miller teaches this limitation but it appears that Miller is analyzing what skills are needed for a project, not in the dimension skills that apply to a

particular user. In other words, if a project needs skill “X” Miller is focused on making sure that members of the selected project have this skill. In contrast, Applicants dimension skills apply to a user, so if a user has skills “A, B, and C” then a progression requirement is identified based on the user, not based upon a particular project (see Miller’s Fig. 2G and related text in para. [0072] with the first step being to select projects and the remaining steps keyed off of the selected projects).

The Office Action contends that Miller teaches Applicants limitation of “*identifying a progression requirement for each of the core skills and the subset of dimension skills.*” Here, Miller does describe a competency model but does not teach or suggest “progression requirements” for any type of job. (design competency model 324 is tied to designing of roles, jobs, etc. block 325 which outlines the competencies needed to support the organizational structure but **does not** teach or suggest any progression requirement. In this limitation, Applicants are claiming a progression requirement for **BOTH** core skills and the subset of dimension skills, which are different types skills as discussed above. Nowhere does Miller (or Mui) teach or suggest any progression requirement for any core skill or dimension skill. Moreover, as discussed above, neither Miller, Mui, nor Magrino differentiate between core skills and dimension. Without such differentiation, as found in Applicants’ claims, the combination of Mui, Miller, and Magrino simply cannot teach or suggest the limitations found in Applicants’ independent claims.

The Office Action contends that Mui/Miller teach Applicants limitation of “*including the retrieved core skills, the subset of dimension skills, and the identified progression requirements in a framework.*” As discussed above, neither Miller nor Mui differentiate between core skills and dimension skills nor does either reference teach or suggest “progression requirements” for both types of skills. Miller discloses a “model” but does not disclose a framework encompassing two distinct types of skills (core and dimension) nor does Miller teach or suggest including “progression requirements” in such model/framework.



Finally, the Office Action contends that Mui/Miller teach Applicants limitation of “*evaluating one of the plurality of users using the framework, the evaluating resulting in an evaluated user.*” as discussed above, Mui/Miller do not teach the framework claimed by Applicants, therefore Mui/Miller do not evaluate any user based upon such framework. In addition, also as discussed above, Applicants framework uses two different types of skills (“core skills” and “dimension skills”) in the framework used to evaluate the user (e.g. the employee). Neither Mui, Miller nor Magrino teach or suggest evaluating a person based upon two different types of skills. At most, the cited art suggests using one type of skill (e.g., dimension skills) in order to ensure that the technical skill is present when evaluation a particular *project* (see Miller, Fig. 2G) but does not teach or suggest evaluating a particular user based on the various skills of the individual user.

As mentioned above, despite the fact that the combination of Mui and Miller fail to teach or suggest the limitations found in Applicants’ original independent claims, Applicants have amended the independent claims and incorporated limitations formerly found in various dependent claims that were rejected as allegedly being obvious over Mui in light of Miller in further view of Magrino.

The Office Action contends that Magrino teaches Applicants’ limitation of “matching the user capability with one of the progression requirements that are included in the framework” (citing para. [0082] of Magrino). However, Magrino does not teach or suggest matching “progression requirements” to “user capabilities.” Instead, Magrino simply teaches “weighting and scoring” a candidate’s actual, current, capabilities and does not teach or suggest anything to do with “progression requirements.” Paragraph [0082] is one of several paragraphs describing the flowchart shown in Fig. 9 and, a review of Magrino’s Fig. 9 reveals that Magrino never teaches or suggests any information that would used to set a path or course of action (“progression”) for a particular capability.

The Office Action contends that Mui teaches “computing a core skill ranking” and “computing a dimension skill ranking.” However, as previously discussed, Mui only

teaches one type of skills and does not differentiate between different types of skills, such as Applicants' "core skills" and "dimension skills." While Mui teaches calculating "an overall rating," this "rating" is not computed based upon two distinct rankings that each relate to a different type of skills (core and dimension), as taught and claimed by Applicants.

Finally, the Office Action contends that Mui teaches "identifying a plurality of user improvement areas based on the core skill rankings and the dimension skill rankings." Mui teaches "competency gap analysis" but does not teach identifying user improvement areas in core skills as well as dimension skills.

As shown above, the combination of Mui and Miller do not teach or suggest all of the limitations found in Applicants' original independent claims. One of the shortcomings of the prior art is that the prior art does not teach or suggest differentiating between "core skills" and "dimension skills" and further does not teach or suggest evaluating a user (e.g., employee) by calculating a rank for both types of skills and then combining the rankings into an overall ranking. As discussed above, Applicants have further amended the claims in order to clarify and further distinguish Applicants' claimed invention and the art of record. Part of the amendments included incorporating limitations formerly found in dependent claims, some of which were rejected as being taught or suggested by Magrino. Applicants have overcome the art of record and respectfully submit that the independent claims are each allowable over the combination of Mui in light of Miller in further view of Magrino.

The remaining claims (claims 5-6, 12-13, and 18-19) are each dependent claims that depend upon one of the independent claims. As such, these claims are each allowable over the art of record for at least the same reasons that the independent claims are allowable.

### **Conclusion**

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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